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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,321	07/22/2002	David Gary Lawton Holt	P1999S004	7817

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6  
EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/069,321

Applicant(s)

HOLT, DAVID GARY LAWTON

Examin r

Jacqueline V. Howard

Art Unit

1764

-- The MAILING DATE f this communicati n appears on the c ver sheet with the correspondenc address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10 is/are rejected.
- 7) ☒ Claim(s) 4-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_.

Claims 5 to 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple claim cannot depend from any other multiple claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robson (5,972,852) or Jahnke (4,118,331).

Robson teaches a lubricating oil composition comprising a synthetic oil basestock and an additive package comprising a dicarboxylic acid or anhydride, an ashless dispersant, a detergent, an antiwear agent and an antioxidant agent. The antiwear agent is a phosphorus/sulfur containing compound. Hindered phenols are specifically taught as antioxidant (col. 8 line 27-28).

Jahnke teaches a lubricant composition comprising an oil of lubricating viscosity, at least one carboxylic acid or its derivative and a phosphorus/sulfur compound (col. 1 lines 10 to 20. The anhydrides of succinic acid are particularly preferred (col. 3 lines 45-55). The basestock oil is the same as that of the instant claims. Also within the scope of the invention is the inclusion of antioxidants, typically hindered phenols, in the composition (col. 5 line 52).

Applicant claims a lubricating oil composition comprising a base oil having less than about 99 wt% saturates and an additive system comprising a sulfur/phosphorus

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anti-wear/extreme pressure additive, a hindered phenol antioxidant and a high molecular weight di-or-poly carboxylic acid, anhydride or mixture thereof.

It is the examiner's position that the claimed invention would be prima facie obvious in view of the above cited prior art because the prior art prepares lubricant composition comprising the same components as in the instant claims. Any benefits resulting from the combination of said components would be there, regardless of whether recognized by patentees or not. It is not unobvious to follow the teachings of the prior art.

The references cited, but not applied further teach lubricant composition comprising additive packages including hindered phenols and/or sulfur/phosphorus anti-wear/extreme pressure additives.

Any inquiry concerning this communication should be directed to J. V. Howard at telephone number (703) 308-2514.

J. Howard/mn  
June 18, 2003

  
JACQUELINE V. HOWARD  
PRIMARY EXAMINER  
GROUP 1700